

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

MAXWELL SHOE COMPANY, INC.,

Plaintiff,

v.

EDELMAN SHOE COMPANY, LLC and
SAM EDELMAN,

Defendants.

Civil Action No. 04-10694 RCL

DECLARATION OF ROGER MONKS

I, Roger Monks, having been duly sworn, state as follows:

1. I am Vice-President of Corporate Services for Maxwell Shoe Company, the plaintiff in the above-captioned case. I am familiar with the footwear market and with competitors in this industry, including defendants Sam Edelman and Edelman Shoe Company.

2. I make this declaration based on my personal knowledge.

3. Maxwell Shoe Company ("Maxwell"), headquartered in Readville, Massachusetts, designs, develops and markets casual and dress footwear for women and children. Maxwell markets its products under a variety of different trademarks, including JOAN & DAVID®, J G HOOK®, and DOCKERS®. Maxwell has been in business since 1949.

4. One of Maxwell's major lines of footwear is sold under the trademark SAM & LIBBY® ("the Mark"). Maxwell has used the Mark continuously since the Spring of 1997 in connection with this line of footwear. It has been a very popular and

successful line for many years, and Maxwell has invested heavily in acquiring and promoting the Mark and developing goodwill associated with it.

5. The SAM & LIBBY® Mark is protected nationwide by U.S. Trademark Reg. Nos. 1,646,905, 1,786,205, 1,772,454, 1,778,203, and 1,898,111.

6. Attached hereto at Exhibit A are copies of registration summaries for Maxwell's U.S. Trademark Reg. Nos. 1,646,905, 1,786,205, 1,772,454, 1,778,203, and 1,898,111. The registration summaries have been printed out from the United States Patent and Trademark Office's Trademark Electronic Search System (TESS). Each of these trademark registrations has become incontestable as a result of the USPTO's acceptance of affidavits of incontestability following more than five consecutive years of use.

7. U.S. Trademark Reg. No. 1,646,905 (SAM & LIBBY® for footwear) originally issued to Sam & Libby, Inc. in 1991.

8. U.S. Trademark Reg. Nos. 1,786,205, 1,772,454, and 1,778,203 (SAM & LIBBY® for clothing including footwear and retail stores featuring clothing and footwear) originally issued to Sam & Libby, Inc. in 1993.

9. U.S. Trademark Reg. No. 1,898,111 (SAM & LIBBY® for leather goods) originally issued to Sam & Libby, Inc. in 1995.

10. Maxwell purchased the SAM & LIBBY® trademark portfolio for \$5.5 million dollars as part of an August 1996 agreement between Maxwell and a company then known as Sam & Libby, Inc., which was owned by Sam Edelman, Louise ("Libby") Edelman, and a third individual, all of whom were also parties to the August

1996 agreement. Attached hereto as Exhibit B are selected portions of the Purchase and Sales Agreement assigning the rights to the SAM & LIBBY® trademarks to Maxwell.

11. At the time of the sale of the trademarks, Sam Edelman was the President and Chief Executive Officer of Sam & Libby, Inc.

12. Maxwell Shoe Company is now the registered owner of the SAM & LIBBY® trademark registrations.

13. In 2003, Maxwell spent in excess of \$1,114,000 promoting the SAM & LIBBY® Mark. In 2002, Maxwell spent over \$914,000 promoting the Mark. Maxwell advertises the SAM & LIBBY® brand in magazines, including Lucky, Cosmopolitan, and In-Style, as well as through flyers, mailers, and newspapers. The SAM & LIBBY® brand is also featured prominently on Maxwell's website.

14. The total sales volume for the SAM & LIBBY® and SAM & LIBBY KIDS® lines of footwear has exceeded \$100 million since the beginning of 2000. In 2003 alone, Maxwell sold \$26.5 million worth of products bearing the Mark. Maxwell's products bearing the SAM & LIBBY® Mark are currently sold in all 50 states as well as in Canada and Puerto Rico. Over 2,400 retail stores nationwide carry the SAM & LIBBY® brands.

15. Defendant Sam Edelman has recently re-entered the shoe business through a company by the name of Edelman Shoe Company. Mr. Edelman and his company have been advertising and promoting a line of shoes similar to Maxwell's SAM & LIBBY® line through trade shows, publications, and stores, and have been associating themselves with the name, reputation, and goodwill of Maxwell's SAM & LIBBY® Mark.

16. On or about March 5, 2004, Mr. Edelman placed a telephone call to an executive of Maxwell Shoe Company. During this call, Mr. Edelman inquired as to whether Maxwell was interested in selling the SAM & LIBBY® Mark back to him.

17. Maxwell did not sell the Mark back to Mr. Edelman and has no interest in doing so. Instead, it wishes to be able to continue selling and promoting its successful SAM & LIBBY® line without interference by the former owner or confusion of the public as to whether Mr. Edelman or his new line of shoes is affiliated with Maxwell.

18. Edelman Shoe Company has applied for trademark registration on the trademarks SAMMY E and SAM BY SAM EDELMAN. Attached as Exhibit C are USPTO TESS summaries of the trademark applications for these marks.

19. On information and belief, Defendant has started to sell shoes using the marks SAMMY E and SAM BY SAM EDELMAN despite the confusing similarity of these marks to Maxwell's SAM & LIBBY® Mark.

20. Maxwell and Edelman Shoe Co. both attend many of the same footwear trade shows, for example the Miami Shoe Show held in February, 2004 and the Metropolitan New York Shoe Market show from March 14-16, 2004. Both companies produce footwear in a similar price range and target the same class of customers.

21. Shoes produced by Maxwell and Edelman are both sold through, and marketed to, the same types of retail outlets. For example, Love My Shoes, a retailer with both five stores and an Internet e-commerce presence, sells the "SAMMY E Closed Toe Slip On" as well as shoes in Maxwell's SAM AND LIBBY® line. The brands SAM AND LIBBY® and SAMMY E are featured together on the same page of that retailer's

website, immediately adjacent to one another. A selected page from the website is attached hereto as Exhibit D.

22. Based on my experience and knowledge of the footwear industry, I am aware of no other shoe company that uses the word SAM in its trademark.


23. Edelman's SAMMY E and SAM BY SAM EDELMAN trademarks are confusingly similar to Maxwell's SAM & LIBBY® Mark. If Edelman's infringement of Maxwell's Mark is permitted to continue Maxwell will suffer irreparable harm to its image, reputation, and market position.

24. Not only are the marks confusingly similar, but in addition, because the SAM & LIBBY® Mark was originally named after Sam & Libby Edelman, who then sold those rights to Maxwell, the confusion in the marketplace that will result from Edelman's use of SAMMY E and SAM BY SAM EDELMAN will be worsened. It is my understanding that both Sam and Libby Edelman have been specifically referring to their history as the original namesakes of the SAM & LIBBY® brand to suggest an association between themselves and their new brand and the Mark that they sold years ago to Maxwell.

25. Attached as Exhibit E is a copy of an article which appeared in the January 26, 2004 edition of "Footwear News." The article discusses the Edelmanns' new shoe company and their connection to the SAM & LIBBY® brand. Attached as Exhibit F is a Sam Edelman advertisement showing his focus on the use of the word "SAM" as a trademark. Also featured is Edelman's use of 877-WEAR-SAM.

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge.

Dated: April 5, 2004



Roger Monks